

REMARKS

Claims 1, 3-4, 6-10, and 13-21 are pending in the present application. Claims 2, 12, and 22-26 were withdrawn; claims 1, 6, 8 and 9 are currently amended. Claims 5 and 11 were cancelled. Reconsideration of the claims is respectfully requested.

Amendments were made to the specification to correct errors and to clarify the specification. No new matter has been added by any of the amendments to the specification.

I. Allowable Subject Matter

Applicant thanks Examiner Renner for the allowance of claims 16-21 and acknowledges the final withdrawal of claims 2, 12 and 24 over applicant's traversal. Applicant further acknowledges the final withdrawal of claims 22-23 and 25-26 over applicant's traversal.

II. Corrections to Drawings

Applicants have submitted replacement sheets to drawings labeled Figures 1, 2A, 2B, and 2C have been designated by legend as Prior Art. In Figure 7, Figure 2 has been changed to Figure 2A. These changes were suggested by the Examiner.

III. Specification

At the Examiner's recommendation, the following informalities were corrected.

- a. In line 4 of claim 1, "at" was deleted for better clarity.
- b. In line 9 of claim 8, --the-- was inserted before the second instance of "first and second storage arrays" in order to properly refer back to their antecedence set forth in line 6 of claim 8.

IV. 35 U.S.C. § 112, Second Paragraph

The Office Action rejects claim 6 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which Applicant regards as the invention. Line 2 in claim 6 was amended to add antecedent basis.

Therefore the rejection of claim 6 under 35 U.S.C. § 112, second paragraph has been overcome.

V. 35 U.S.C. § 102, Anticipation Lemelson (US 3,646,258)

The Office Action rejects claims 1, 5, 7-8, 11, 13 and 15 under 35 U.S.C. § 102 as being anticipated by Lemelson (US 3,646,258). This rejection is respectfully traversed.

MPEP § 2131 provides:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

1. Claims 1, 5 and 7 - Lemelson Does Not Teach a Path in an Interior Space

All elements in claim 1 are not disclosed in the Lemelson. The Office Action mailed April 9, 2004 (section 8), states:

With respect to claims 1,5, and 7, Lemelson teaches a data storage library (FIG. 1, for instance) comprising first and second arrays of storage cells, ... the first and second arrays describing an interior space between the first and second arrays (as shown in FIG. 1, for instance)... wherein a robotic picker (includes 22, for instance, in the sense that it chooses or picks a storage element array) is translatable along a path (includes 35, for instance), the path located within the interior space ...

[Emphasis added]

Here the Office Action describes Lemelson as defining the interior space as "the first and second arrays describing an interior space between the first and second arrays (as shown in [Lemelson] FIG. 1, for instance)." The Office Action further indicates that path (35) (as indicated in Figure 1) is located within this interior space.

The Applicant respectfully points out that the interior space as described above would correspond to the second column of arrays in Lemelson Figure 1 as pointed out by the Office Action, but would not include the space occupied by the path (35). The path (35) in Lemelson is not in the interior space as defined by the Examiner's description in the Office Action.

With respect to Applicant's claim 1, Lemelson does not contain every element recited in the claim. The elements that state, "that the path of the robotic picker is translatable along a path that is located within the interior space" is not taught in Lemelson. The interior space is described (in this embodiment of the invention) by the first and second arrays as being between the first and second arrays. Clearly path 35 in Lemelson is outside the interior space. Therefore the rejection is unsupported by Lemelson and it is respectfully requested that the rejection be withdrawn.

Since claim 7 depends from claim 1, the above arguments hold and therefore the rejection is unsupported and it is respectfully requested that the rejection be withdrawn. The argument is moot concerning Claim 5 in that it has been cancelled.

2. Claims 8, 13 and 15 - Lemelson Does Not Teach Opposite Side Storage Arrays Facing Each Other

Additionally, claims 8, 13 and 15 claim another feature not suggested by Lemelson. Lemelson does not include claim elements that state that the storage arrays positioned on opposite sides of a storage area be "facing each other".

The Office Action states, "...first and second storage arrays (as shown in FIG.1, for instance, i.e., the first and third columns of storage arrays, for instance) within the plurality of storage arrays positioned on opposite sides of the storage area facing each other (as shown in FIG. 1, for instance)..."

The Applicant respectfully points out that the storage arrays taught in Lemelson Figure 1 are not facing each other but are adjacent as described in the detailed description (Lemelson column 3, lines 44-45). "Magazines 42 are shown arranged adjacent to each other and are tiered in vertical rows one above the other."

Applicant's claim 8 states in part, "first and second storage arrays within the plurality of storage arrays positioned on opposite sides of the storage area facing each

other.” Since Lemelson’s Figure 1 does not teach storage areas facing each other, these elements of Applicant’s claim 8 is not met. Consequently, it is respectfully urged that the rejection of claim 8 has been overcome according to Lemelson.

Since claims 13 and 15 depend from claim 8, the above argument holds for those claims and therefore their rejections are unsupported and it is respectfully requested that the rejections be withdrawn. The argument is moot as to Claim 11 in that Claim 11 has been cancelled.

VI. 35 U.S.C. § 102, Anticipation Hug et al. (US 4,817,070)

The Office Action rejects claims 1, 3-4, 6-8, 10 and 13-15 as being anticipated by Hug et al. (US 4,817,070).

1. Claims 1, 3-4 and 6-7 Hug Does Not Teach A Path Having Access to Each Storage Array (Claim 1 Amended)

Claim 1 has been amended to incorporate the original limitations of claim 5.

1. (Currently Amended) A data storage library, comprising:
first and second arrays of storage cells, the storage cells in the first and second arrays being operable to receive data storage elements, the first and second arrays describing an interior space between the first and second arrays; and
a third array of storage cells, the storage cells in the third array being operable to receive data storage elements, the third array being substantially located within the interior space;
wherein a robotic picker is translatable along a path, the path located within the interior space; and
wherein the path has sections adjacent to each storage array of the library such that the robotic picker can access any storage array by translating to it along the path.

The Office Action did not reject claim 5 as being anticipated by Hug. Since claim 5 was not anticipated by Hug, amended claim 1, including all of the original limitations of claim 1 and of claim 5, is not anticipated by Hug. Since claims 3-4 and 6-7 depend from claim 1 it is respectfully requested that the rejection be withdrawn from these claims. The argument for Claim 5 is moot in that Claim 5 has been cancelled.

2. Claims 8, 10, 13-15 Hug Does Not teach a Path Passing Continuously Past Each of the Storage Arrays (Claim 8 Amended)

Claim 8 has been amended to include the original limitations of claim 11.

8. (Currently Amended) A data storage library, comprising:
a storage area having a plurality of storage arrays, the arrays capable of storing individual data storage elements;
an access device capable of accessing data storage elements from the plurality of storage arrays, the access device being translatable along a path;
wherein the path passes continuously past each of the storage arrays of the plurality such that the access device can access any storage array of the plurality by translating along the path; and
first and second storage arrays within the plurality of storage arrays positioned on opposite sides of the storage area facing each other; and
a third storage array within the plurality of storage arrays positioned substantially parallel to the first and second storage arrays and positioned between the first and second storage arrays.

The Office Action did not reject claim 11 as being anticipated by Hug. Since claim 11 was not anticipated by Hug, amended claim 8, including all of the original limitations of claim 8 and of claim 11, is not anticipated by Hug. Since claims 10 and 13-15 depend from claim 8 it is respectfully requested that the rejection be withdrawn from these claims.

VII. Claims 1, 5 and 7 -Prior Art Figure 2A Does Not Teach The Path Located Within the Interior Space

The Office Action rejects claims 1, 5 and 7 as being anticipated by Applicant's admitted prior art Figure 2A.

The Office Action describes Figure 2A as defining the interior space as "the first and second arrays describing an interior space between the first and second arrays (202 and 208, for instance)." The Office Action further indicates, "wherein a robotic picker (210) is translatable along a path (as shown in FIG. 2A, for instance), the path located within the interior space and comprising sections that pass adjacent to at least some of the arrays (as shown in FIG. 2A, for instance) [as per claim 1].

Claim 1 has been amended to read:

- (Amended) A data storage library, comprising:

first and second arrays of storage cells, the storage cells in the first and second arrays being operable to receive data storage elements, the first and second arrays describing an interior space between at the first and second arrays;

a third array of storage cells, the storage cells in the third array being operable to receive data storage elements, the third array being substantially located within the interior space;

wherein a robotic picker is translatable along a path, the path located within the interior space; and

wherein the path has sections adjacent to each storage array of the library such that the robotic picker can access any storage array by translating to it along the path.

[Emphasis added]

The prior art in Figure 2A does not contain all of the elements in Applicant's claim 1. The elements stated below are not contained in prior art Figure 2A.

wherein a robotic picker is translatable along a path, the path located within the interior space;

The interior space as described in the Office Action would correspond to storage arrays 204 and 206 for instance. But the interior space would not correspond to the paths outside storage arrays 202 or 208 for instance. The path 202 in the prior art Figure 2A is not in the interior space as defined by the Examiner's description.

The interior space is described in claim 1 as between the first and second arrays. The path in Figure 2A [202] is located outside the interior space as described by claim 1. The amended claim 1 indicates in this embodiment "the robotic picker can access any storage array by translating to it along the path." Since Figure 2A shows the paths adjacent to 202, 212, and 208 outside the interior space, Figure 2A does not show all of the elements of amended claim 1. Therefore the rejection is unsupported by Figure 2A and it is respectfully requested that the rejection be withdrawn.

Since claim 7 depends from claim 1, the above arguments hold and therefore the rejection is unsupported and it is respectfully requested that the rejection be withdrawn. The argument as to Claim 5 is moot in that Claim 5 was cancelled.

Therefore, claims 1, 3-8, 10 and 13-15 are in condition for approval.

VIII. Allowable Subject Matter

The Office Action stated that claim 9 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, claim 9 has been rewritten to overcome this objection.

IX. Conclusion

It is respectfully urged that the subject application is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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